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Please find below and/or attached an Office communication concerning this application or proceeding.

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1   RECORD OF ORAL HEARING
2
3   UNITED STATES PATENT AND TRADEMARK OFFICE
4   _____
5
6   BEFORE THE BOARD OF PATENT APPEALS
7   AND INTERFERENCES
8   _____
9
10 Ex parte JOEL RONNING and KELLY WICAL
11   _____
12
13   Appeal 2009-1369
14   Application 09/492,844
15   Technology Center 3600
16   _____
17
18   Oral Hearing Held: April 7, 2009
19   _____
20
21

22 Before HURBERT C. LORIN, DAVID B. WALKER, and BIBHU R.
23 MOHANTY, Administrative Patent Judges
24
25 ON BEHALF OF THE APPELLANTS:
26
27   SHAWN B. DEMPSTER, ESQUIRE
28   NORTH OAKS PATENT AGENCY
29   45 ISLAND ROAD
30   NORTH OAKS MN 55127
31
32   The above-entitled matter came on for hearing on Tuesday, April 7,

33 2009, commencing at 9:40 a.m., at The U.S. Patent and Trademark Office,

34 600 Dulany Street, Alexandria, Virginia, before Christine L. Loeser, Notary

35 Public.

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1   JUDGE LORIN: Good morning, Counsel.

2   MR. DEMPSTER: Good morning.

3   JUDGE LORIN: Counsel, could you state your name clearly for the

4   court reporter, please.

5   MR. DEMPSTER: Yes. It's Shawn Dempster.

6   JUDGE LORIN: Okay. Counsel, we are ready. We are familiar with

7   the record. You may proceed. You have 20 minutes.

8   MR. DEMPSTER: Well, we are here today to talk about a very, very

9   old patent application. The earliest priority date goes back to 1998, and one

10   of the references, Downs, predates that priority date by approximately three

11   months. The Downs patent also is in the same field. It's in software

12   downloads.

13   Our client is and has been in the software download business since its

14   inception, was one of the early pioneers and to date offers these services to

15   many customers such as Symantec, Microsoft, McAfee and many other

16   software publishers.

17   If we look at record here, it has had, if you have had a chance to read

18   it, a somewhat tortuous past. I am the latest person in line, working on this

19   case. It was originally written by a colleague of mine, and it's been through

20   a couple of rounds of examination before it got to this point.

21   If has been very difficult to get an actual prima facie case of

22   obviousness stated by this Examiner, and quite frankly, at least in my

23   opinion, we didn't really see one until the Examiner's Answer in this appeal.

24   At that time, we did finally have something that we could talk about

25   but it was too late to do anything more about the claims or with anything

26   else. At the end of the day, there was still, at least in our opinion, two items

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1   that were missing from that case that was stated by the Examiner.

2   Those two things are fairly fundamental to this particular kind of

3   software download. One of the biggest problems we face is identifying

4   whether or not there is fraudulent activity. In particular, it's not uncommon

5   for one guy to buy a piece of software, get the license, download the

6   software and then pass that license key on to another.

7   That is a problem for our publishers because they would prefer to get

8   paid for each one of those installations of software.

9   The approach that Downs took to this was to allow a download a

10 single time, and they set up a fairly elaborate system -- it was a good system

11 -- that allowed for a verification process that was a one-way process.

12   So an order would come in, the credit card would be taken, checked,

13 and once that was done, a license entitlement would be provided to the end

14 user. That end user would then take that license entitlement and transfer it

15 off to the download service, whoever was actually hosting that download.

16   However, the download service, all they could do was look at the

17 license key that they got. It was a public key kind of transaction where it

18 was a one-way encryption and determine whether or not that was a valid

19 key. If it was, then they allowed download of the software.

20   In contrast, this inventor took a very different approach. He said, I

21 need to go a little deeper than that because I want to allow the customer to

22 make more than one download. It's not uncommon for someone to start a

23 download process and not finish it, or they will download it, something goes

24 wrong and they need to redownload it.

25   So what we needed to do was allow others to download more than

26 once but not too many times. And we needed to know that it was the same

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1   person.

2   Based on that particular need, we added two things. One was the

3   order ID verification process that is in each of the independent claims, and

4   the second is even if the verification process works, don't let them download

5   more than three times or multiple times.

6   Three times I am using because the other reference that was cited was

7   Rogers and in that reference, they talked about three times. Fair enough, we

8   can use the number three if they would like to for this discussion, but the

9   idea is at least after a certain number of downloads, to stop that.

10   The order of verification process is a very important one for us. We

11   are looking for three key things. These are all things that Downs had no idea

12   that they needed to do and didn't describe in their specification.

13   In particular, drawing your attention to claim 1 and what was missing

14   was checking whether or not the order ID was valid because it is actually an

15   existing order.

16   In some respects, a process of looking at a public key may be able to

17   do the similar kind of thing. Not actually looking at the ID but just looking

18   at whether or not the license key is valid may accomplish that same task.

19   However, the final two steps in that process aren't possible with such a

20   system. In particular, we are looking to see if that order was canceled before

21   the download of the file.

22   So in the time between when that license key was granted in Downs

23   and when somebody actually requests to download that file, we have an

24   independent communication going back to the download manager to tell

25   them, No, don't allow the download of that particular key. We have found

26   some problem with the transaction.

1   In addition, if it's been downloaded once and we have determined or

2   detected that it is actually being downloaded from other parts of the country

3   or other countries, this client actually stops the download process and says,

4   Don't let anyone else download this file, regardless of how many times it has

5   been downloaded. That is part of the order identification process.

6   Are there any questions?

7   JUDGE LORIN: No. I don't have a question at the moment, but I

8   would like you to further explore this verification process that you are using.

9   MR. DEMPSTER: Sure. This verification process is fairly well

10   described. I think it is in figures 5A through 5C, if I remember correctly. It

11   is very critical to us to be able to have a communication going between

12   whoever is managing the license and the downloading site, the content site.

13   That is something that is not found in Downs. In fact, if you look at

14   figure 6 of Downs, they don't even show a communication link between the

15   two so it isn't even possible for them to do such a verification process.

16   JUDGE LORIN: Can you tell me precisely what you believe the

17   Examiner is pointing to as describing or disclosing that limitation in the

18   verification limitations in your claim?

19   MR. DEMPSTER: Sure. I think he is looking at the license key itself

20   that is being passed and saying that does an equivalent process, because this

21   key that is -- this encrypted file that is being sent back to the user who then

22   sends it on to the download manager has certain features.

23   It has already been verified as being accurate and valid. It's all a

24   matter of timing, quite frankly. Downs is doing lot of things up front at the

25   time of an order being placed, and what we are doing is we are saying, Yeah,

26   that's great but we need to do some post-order activity in the verification

1   process. That is not something that Downs got to.

2   JUDGE LORIN: My understanding, the Examiner was looking to a

3   clearinghouse in Downs as suggesting that verification, those three

4   verification steps in your claim.

5   MR. DEMPSTER: Yeah. The clearinghouse is the function that is

6   being done at the time of the purchase of that download, a piece of music,

7   for example.

8   In some respects, if that was something done later in time, then it

9   would be performing similar kinds of steps, but it is nearly identical to the

10   kinds of things that our client is doing at the time of an order, not at the time

11   of the download. At the time of download, there's nothing new being done

12   by Downs.

13   JUDGE LORIN: So let's see if I understand you correctly. Well,

14   backing up for a second, the Examiner, my understanding of the Examiner,

15   was that it was the clearinghouse and the process of authorizing the

16   download that the Examiner interpreted as suggesting the three verification

17   steps that you are claiming.

18   MR. DEMPSTER: Yeah. And that's an interesting notion except two

19   of those verification processes can't be done until after a download has either

20   occurred or at least after a purchase has occurred.

21   JUDGE LORIN: Right. That's right. That's what you are arguing.

22   Could you explain that a little further --

23   MR. DEMPSTER: Sure.

24   JUDGE LORIN: -- why that must be the case?

25   MR. DEMPSTER: Sure. When you are verifying whether or not the

26   order was not canceled, that means the order has to have already been

1 placed. When you are verifying whether or not it is canceled after a

2 download of a file, that means at least one download has had to have

3 happened already.

4 In the Downs system, only one download is permitted. In fact, they

5 actually keep a database where they take and they look at the license key and

6 the Examiner actually pointed to it and determined whether or not it has ever

7 been downloaded before. If it has, they don't let a second download occur.

8 JUDGE LORIN: That refers to the transaction, the database that is

9 collecting the transactions?

10 MR. DEMPSTER: Yes. The transaction database.

11 JUDGE LORIN: The transaction IDs, that is what you are speaking

12 of?

13 MR. DEMPSTER: Mm-hmm. That's right.

14 JUDGE LORIN: So if I understand you correctly, you are saying that

15 these verification steps are determining if the order identifier is valid for the

16 order that is active and it's non-suppressed are not only not suggested or

17 disclosed.

18 MR. DEMPSTER: They are not possible.

19 JUDGE LORIN: Not possible. Okay, Counsel.

20 Other questions?

21 Thank you very much.

22 MR. DEMPSTER: Very easy to address. Did you want to talk about

23 the Rogers reference at all? I know it's a non-analogous art but I think that

24 was fairly well stated.

25 JUDGE LORIN: Yeah. That's the argument you made in your brief.

26 I think we understand that argument.

1   MR. DEMPSTER: I don't know if I have much more to say about

2   that.

3   JUDGE LORIN: Right, right. Thank you, Counsel.

4   MR. DEMPSTER: This was definitely the harder one to explain.

5   (Whereupon, the proceedings at 9:52 a.m. were concluded.)

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